

Application No. 09/768,667
Response Under 37 C.F.R. § 1.116 dated October 9, 2006
Reply to Office Action of July 14, 2006

REMARKS

Status Of Application

Claims 42, 44, 46, 56, and 57 are pending in the application; the status of the claims is as follows:

Claims 42, 44, 46, 56, and 57 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,737,014 to Tojo et al. ("Tojo") in view of U.S. Patent No. 4,897,732 to Kinoshita et al. ("Kinoshita") and U.S. Patent No. 5,034,804 to Sasaki et al. ("Sasaki").

Claims 42, 44, 46, 56, and 57 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,833 to Taka ("Taka") in view of Sasaki.

Incomplete Office Action

Pursuant to MPEP 707.07(f):

"In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

In a response filed April 25, 2006, substantial amendments to the claims were made in which some claim elements were eliminated and other claim elements were added. Arguments were presented differentiating the amended claims from the cited art, *i.e.*, Tojo, Taka, Kinoshita, and Sasaki. It appears that the present office action merely reiterates the rejections made in the prior office action without taking into consideration

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any of the amendments and/or arguments. For example, in rejecting claim 42 the present office action discusses claim elements which are no longer present, *e.g.*, “first storing means ...”, “changer means ...”, etc. Indeed, a cursory comparison suggests that these portions of the rejections were copied from the previous office action and pasted into the new office action without any changes (identical grammatical, spelling, and punctuation errors).

In light of the above, it is respectfully requested that the current office action be withdrawn and a new office action issued which, pursuant to MPEP 707.7(f), takes note of and answers the substance of the amendments and arguments set forth in the response filed April 25, 2006.

35 U.S.C. § 103(a) Rejections

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.” MPEP 706.02(j).

The rejections of claims 42, 44, 46, 56, and 57 under 35 U.S.C. § 103(a), as being unpatentable over Tojo in view of Kinoshita and Sasaki and over Taka in view of Sasaki are respectfully traversed because a *prima facie* case against the amended claims has not been established in that the rejection does not established that the prior art references teach or suggest all the claim limitations.

The present application discloses a camera capable of recording an image in both a first memory, which is a memory card detachably installed inside the camera body, and a

second memory, which is fixedly installed inside the camera body. In such a camera, generally, the first memory and the second memory are used for different purposes. Namely, the first memory is used as a main memory and the second memory is used as a spare memory. A user primarily records image information of taken pictures in the first memory. However, when a user cannot record the image information in the first memory (for example when the memory card is full, and a spare card is not available), the second memory is used to record the image information. An image which is important for a user is assumed to be primarily recorded in the first memory rather than in the second memory. Thus the present invention is advantageous in that reproduction of the important images is more convenient, because the images stored in the first memory are reproduced with priority over images in the second memory.

This feature of the invention is present in previously amended claim 42 which recites, *inter alia*, “a controller for controlling the reproduction device so that image information in the second memory is reproduced by the reproduction device when the detector detects that the first memory is not attached, while image information in the first memory is preferentially reproduced by the reproduction device when the detector detects that the first memory is attached.” The office action does not even allege that the prior art teaches or suggests that images from a memory card are “preferentially reproduced” when the controller detects that a memory card is attached. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established against claim 42. Because claims 44, 46, 56, and 57 depend from claim 42, it is respectfully submitted that a *prima facie* case of obviousness has also not been established against these claims.

Accordingly, it is respectfully requested that the rejection of claims 42, 44, 46, 56, and 57 under 35 U.S.C. § 103(a) as being unpatentable over Tojo in view of Kinoshita and Sasaki, and over Taka in view of Sasaki, be reconsidered and withdrawn.

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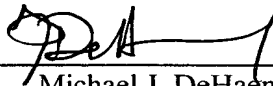
CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin LLP Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By: 

Michael J. DeHaemer
Registration No. 39,164
Attorney for Applicants

MJD/llb:bar:jkk
SIDLEY AUSTIN LLP
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Direct: (214) 981-3335
Main: (214) 981-3300
Facsimile: (214) 981-3400
October 10, 2006